



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/784,631	02/15/2001	Jose A. Fernandez-Pol	42108.0106	2674
21888	7590	06/02/2005	EXAMINER	
THOMPSON COBURN, LLP			COPPINS, JANET L	
ONE US BANK PLAZA			ART UNIT	
SUITE 3500			PAPER NUMBER	
ST LOUIS, MO 63101			1626	

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/784,631

Applicant(s)

FERNANDEZ-POL, JOSE A.

Examiner

Janet L. Coppins

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 13-53 and 65-114 is/are pending in the application.
- 4a) Of the above claim(s) 13-20, 25-35, 40-53 and 65-114 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-24 and 36-39 is/are rejected.
- 7) ☒ Claim(s) 23, 24, 36 and 37 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

Handwritten signature/initials.

### **DETAILED ACTION**

Claims 13-53 and 65-114 pending in the instant application.

#### ***Response to Amendment***

1. Receipt is acknowledged of Applicants' Response, filed February 23, 2005.

Accordingly, claims 13-20, 25-35, 40-53, and 65-114 remain withdrawn from consideration (as well as claims 21-24 and 36-39 in part, that are not drawn to methods of using ophthalmic preparations), and claims 21, 36, 38, and 39 have been amended.

#### ***Claim Rejections - 35 USC § 112***

2. Claims 21-24 and 37-39 previously rejected under 35 USC 112, second paragraph, as being indefinite. In view of Applicants' amendatory changes, the Examiner withdraws the rejections to the claims.

#### ***Claim Rejections - 35 USC § 102***

3. Claims 21, 24, 36, 39 previously rejected under 35 U.S.C. 102(b) as being anticipated by U.S. 3,474,168, Schayer et al. In view of Applicants' persuasive arguments, the Examiner withdraws the rejections to the claims.
4. Claims previously rejected under 13-53 and 65-111 under 35 U.S.C. 102(f). In view of Applicants' persuasive arguments, the Examiner withdraws the rejections to the claims.

#### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

Art Unit: 1626

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 21-24 and 36-39 previously rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 7, 8, 13-15 and 22 of U.S. Patent No. 6,407,125, or claims 1, and 4-7 of U.S. Pat. No. 6,127,393, and claims 1-25 of U.S. Pat. No. 6,410,570. Applicants have currently deferred addressing this rejection, therefore the double patenting rejections are still pending.

Claims 21, 22, 38, and 39 newly rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Pat. No. 6,403,618 B1, also to Fernandez-Pol and assigned to Novactyl, Inc. The '618 patent teaches and recites a metal ion chelating agent with antiangiogenic properties, for treating retinopathy of the eye. The compound claimed in the '618 patent is the same as the structure recited in the instant claims.

### ***Claim Objections***

7. Claims 23, 24, 36, and 37 are also objected to as depending from rejected base claims.

### ***Conclusion***

8. In conclusion, claims 13-53 and 65-114 are pending, and claims 13-20, 25-35, 40-53 and 65-114 have been withdrawn from consideration. Claims 21-24 and 36-39 stand rejected, and claims 23, 24, 36, and 37 are objected to.

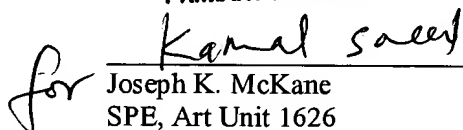
***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet L. Coppins whose telephone number is 571.272.0680. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571.272.0699. The fax phone number for the organization where this application or proceeding is assigned is 571.272.8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Janet L. Coppins  
May 30, 2005

KAMAL A. SAEED, PH.D.  
PRIMARY EXAMINER  
  
for Joseph K. McKane  
SPE, Art Unit 1626